

REMARKS

Status of the claims

With entry of the instant amendment, claim 22 and claims 24-33 have been cancelled and new claims 34-36 have been added. Claims 1-21, 23, and 34-36 are therefore pending. Cancellation of subject matter is without prejudice to prosecution in a subsequent divisional or continuation application.

The amendment to claim 21 adds no new matter and incorporates elements of claim 22, now cancelled.

New claims 34-36 add no new matter and are supported throughout the specification as filed.

Applicants thank the Examiner for discussing the restriction requirement on October 30, 2006. The restriction of generic claim 1 into multiple groups was discussed, as was the potential addition of new claims.

Restriction requirement

In response to the restriction requirement, Applicants provisionally elect Group VII, insofar as it relates to a method for identifying an agent for treating a diabetic or pre-diabetic individual comprising contacting a candidate agent with a polypeptide having glucose phosphorylating activity that comprises at least 20 contiguous amino acids of SEQ ID NO:2; determining binding of the agent to the polypeptide; selecting an agent that decreases the activity of the polypeptide; administering the agent to a diabetic or pre-diabetic animal; determining the response of the animal to glucose; and selecting an agent that improves the response to glucose. The claims that read on the elected group are claims 21, 23, and 34-36. This election is made with traverse.

The Examiner has described Group VII as relating to a candidate agent that is siRNA and determining levels of an RNA. However, none of the claims recite such elements. Indeed, the method relates to contacting the polypeptide with the candidate agent; not contacting

a nucleic acid encoding the polypeptide with the candidate agent. Accordingly, the Examiner has incorrectly characterized claims 21, 23, and 34-36.

Further, by defining Group VII as relating to an siRNA and determining levels of an RNA, the Examiner has essentially presented a de facto rejection of claim 21 as filed without examining the claim, and has arbitrarily re-defined and restricted Applicants' invention. This is improper and has been expressly prohibited. The Court of Customs and Patent Appeals (CCPA) decided this issue in *In re Weber, Soder, and Boksay*, 198 U.S.P.Q. 328 (C. C. P. A., 1978) ("*Weber*"). In *Weber*, the Court stated that

[a]s a general proposition, an applicant has the right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant to eventually have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim...(Id. at 331)

Weber specifically disallows the Patent Office from refusing to examine a single claim on the merits simply because the Patent Office believes that the claim is drawn to independent and distinct inventions. Rather, the "basic right of the applicant to claim his invention as he chooses" under § 112 is "paramount" over the Patent Office's right to control "such administrative matters as examiner caseloads and amount of searching done per filing fee." See *Weber* at 332. With regard to Group VII, the Examiner has refused to consider claim 21 as drafted, but instead, by defining the restriction group as relating to siRNA and detecting levels of RNA, has insisted upon only examining a very small portion of the subject matter. Thus, defining Group VII as proposed by the Examiner denies Applicants their right to claim their invention as they choose and have each claim considered on the merits.

Similarly, the restriction of claim 1 into three groups, Groups I-III, and claim 10 into three groups, Groups IV-VI, is improper based on the same premise explained above.

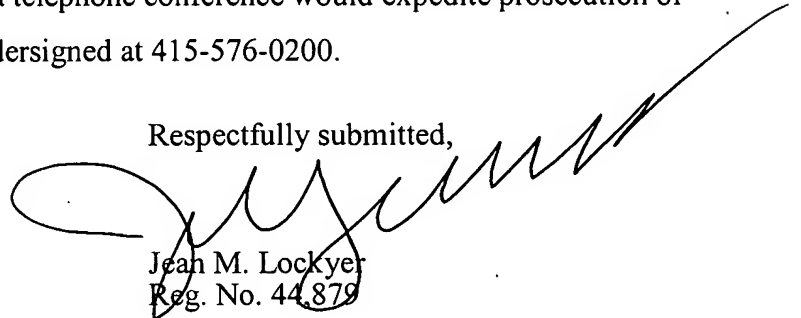
The patent office has specifically provided for the situation of a generic claim in the form of species election. Accordingly, Applicants propose that the Examiner consider allowing Applicants to elect a species of candidate agent encompassed by the generic claim, claim.21, to facilitate prosecution on the merits. An example of such a species set forth in the specification is a small organic molecule.

In view of the foregoing, Applicants respectfully request that the current restriction requirement be withdrawn.

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Jean M. Lockyer
Reg. No. 44,879

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
JML:jml
60885944 v1